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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,804	04/25/2000	Roger Bruce Harding	1313/1F022-US1	8941

7590

04/04/2003

Darby & Darby PC  
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New York, NY 10022

EXAMINER

WHITE, EVERETT NMN

ART UNIT PAPER NUMBER

1623

DATE MAILED: 04/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/557,804

Applicant(s)

HARDING ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 1-38 and 40-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39 and 60-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. The amendment and appeal brief filed January 15, 2003 have been received, entered and carefully considered. The amendment and appeal brief affects the instant application accordingly:
  - (A) Claim 64 has been canceled.
  - (B) Comments regarding Office Action have been provided drawn to:
    - (a) 103(a) rejection, which has been withdrawn.
2. Claims 1-63 are pending in the case. Claims 1-38 and 40-59 have been withdrawn from consideration. The instant Office Action is directed to Claims 39 and 60-63.
3. The text of those sections of title-35, U. S. Code not included in this action can be found in a prior Office action.

### ***Finality Withdrawn***

4. After review of the issues in the case and consideration of the appeal brief, the finality of the rejection filed September 18, 2002 is withdrawn, and prosecution on the merits is reopened.
5. The appeal is being held in abeyance.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 39 and 60-63 are rejected under 35 U.S.C. 102(a) as being anticipated by Mansikkamaki et al (EP 0879827, already of record).

Applicants claim a carboxymethyl cellulose ether prepared by a method comprising the steps of: (a) obtaining mercerized and recovered cellulose pulp; and (b) converting the mercerized and recovered cellulose pulp into carboxymethyl cellulose, wherein the mercerized cellulose pulp in step (a) was mercerized with a cellulose II mercerizing agent, and the mercerized and recovered cellulose pulp has a TAPPI 230 om-89 viscosity greater than 12 cP, when the cellulose pulp is southern softwood kraft. Additional independent claims drawn to the carboxymethyl cellulose ether product with additional process steps are set forth. Additional limitations in the dependent claims include the cellulose pulp being a sulfite cellulose pulp and further process steps for preparing the carboxymethyl cellulose ether.

The Mansikkamaki et al patent discloses carboxymethyl cellulose that may be derived from sulphite softwood pulp (see page 2, line 14), which embraces the softwood kraft cellulose pulp used in the preparation of instant Claims 39 and 60-64. Mansikkamaki et al also shows that mercerization of cellulose pulp during preparation of carboxymethyl cellulose is known in the art (see page 2, lines 18-21). The Mansikkamaki et al patent sets forth, in Table 2 on page 3 of the document, viscosity values for the carboxymethyl cellulose thereof that are greater than 12 cP, which embraces the viscosity values disclosed in the instant claims. The carboxymethyl cellulose ether of the instant claims differs from the carboxymethyl cellulose of the Mansikkamaki et al patent by setting forth the instant claims in product-by-process forms. However, process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), *supra*; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. The instantly claimed carboxymethyl cellulose ether product, per se, does not appear to indicate characteristics that make the product different and therefore patentable over the carboxymethyl cellulose ether product of the Mansikkamaki et al patent. Accordingly, the carboxymethyl cellulose ether disclosed in the Mansikkamaki et al patent anticipates the carboxymethyl cellulose ether of the instant claims.

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8. Applicant's arguments with respect to claims 39 and 60-63 have been considered but are moot in view of the new ground(s) of rejection.

**Summary**

9. Claims 39 and 60-63 are rejected; Claims 1-38 and 40-59 are withdrawn from consideration as being directed to nonelected inventions. Claim 64 has been canceled.

**Examiner's Telephone Number, Fax Number, and Other Information**

10. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

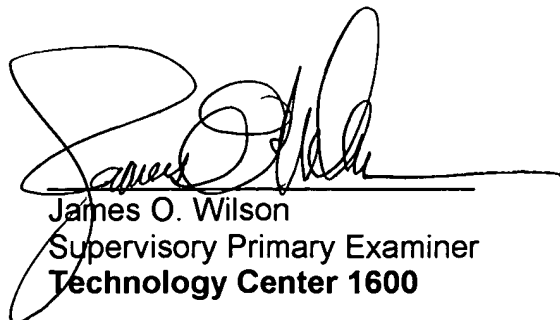
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

*E. White*

E. White

  
James O. Wilson  
Supervisory Primary Examiner  
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